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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/889,645	01/24/2002	Anne Gillian Welch	9013.31	8639

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EXAMINER

WINKLER, ULRIKE

ART UNIT	PAPER NUMBER
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1648

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

S.M.

Office Action Summary**Application No.**

09/889,645

Applicant(s)

WELCH ET AL.

Examiner

Ulrike Winkler

Art Unit

1648

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The Amendment filed November 18, 2003 in response to the Office Action of July 15-2003 is acknowledged and has been entered. Claims 15-19 have been added. Claims 1-19 are pending and are currently being examined.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.

Claim Objections

The objection of claim 14 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n) is withdrawn in view of Applicant's amendment to the claim.

Claim Rejections - 35 USC § 103

The rejection of claims 1-19 under 35 U.S.C. 103(a) as being unpatentable over Nebe (WO 96/05846, IDS Paper No. 1), Omar et al. (U.S. Pat. No. 5,696,236, IDS Paper No. 1) and Savage et al. (EP 0 798 003 A2, IDS Paper No. 1) **is maintained** for reasons of record.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant's arguments are that the filter used by Nebe is not effective at "removing" prion. This is not convincing because the Nebe reference clearly set out that the prefilter alone

Art Unit: 1648

removed half of the infectious agent (see page 13), indicating that the prion agent has a high binding affinity for the prefilter material. Applicant's specification has not defined the term "removal" to be a complement elimination of the infectious agent. The word "remove" is given the plain meaning (see Webster's dictionary) of changing location, taking away, to get rid of, to be capable of being removed, or a degree or stage of separation. Therefore, applicant's arguments are not convincing because the Nebe reference clearly sets out method steps comprising the use of a pre-filter which results in the removal of prion protein from the solution.

Nebe (WO 96/05846, IDS Paper No. 1) teaches the removal of prion from solution utilizing a series of membrane or ultramembrane filters. The method teaches using a prefilter of nylon gauze and nylon membrane filters ranging in size from 2 microns to 0.2 microns (see page 10). The filters can be arranged in a series. The reference indicated that prion particles can be removed from the liquid and as an additional benefit at the same time other infectious material can be removed such as bacteria, viruses and endotoxins (page 6). The reference also teaches that the prefilter alone removed half of the infectious agent (see page 13), indicating that the prion agent has a high binding affinity for the prefilter material. The reference does not disclose the pore size of the nylon premembrane filter. The reference does not teach using kieselguhr, perlite particles or diatomaceous earth in the prefiltration step.

Omar et al. teaches separating virus from protein solution using an absorbent (binder) that is either diatomaceous earth, perlite or kieselguhr (see claims). The method purifies a human blood plasma solution for the purpose of producing safe blood products (column 1, lines 10-30).

Art Unit: 1648

Savage et al. teach a method of removal of viruses from an aqueous liquid containing proteins, the method comprises the steps of passing the liquid through a depth filter formed of matrix comprising porous elements having a size 0.25 –2 microns.

It would have been obvious to one of ordinary skill in the art to utilize a depth filter, which is ordinarily used in the art as a prefilter for ultramembrane filtration (Savage et al. page 2, lines 47-48), for the removal of prion particles from a liquid based on the teaching of Nebe which indicated that half of the infectious prion was removed using the nylon premembrane filter (depth filter) indicating that the prion has a high nonspecific affinity for the prefiltration media. Furthermore, one having ordinary skill in the art would have a high expectation of success utilizing the matrices of Omar et al. and Savage et al. for the removal of infectious agent from blood plasma products. Therefore, the instant invention is rejected over Nebe, Omar et al. and Savage et al.

Conclusion

Claims 1-19 are rejected.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 1648


the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ulrike Winkler, Ph.D. whose telephone number is 571-272-0912. The examiner can normally be reached M-F, 8:30 am - 5 pm. The examiner can also be reached via email [ulrike.winkler@uspto.gov].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached at 571-272-0902.

The official fax phone number for the organization where this application or proceeding is assigned is 703-872-9306; for informal communications please the fax phone number is 571-273-0912

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


ULRIKE WINKLER, PH.D.
PATENT EXAMINER 2/23/04